

Claims 1, 3, 5, 6, 10, 11, 13, 14, 17 – 24, 25, 29, 38 are amended, claims 2, 9, 15, 16, 32, 33, 34, 35, 36, 37 are canceled, and claims 40, 41 are added; as a result, claims 1, 3 – 8, 10 – 14, 17 – 31, 38 – 41 are now pending in this application.

#### **Affirmation of Election**

Restriction to one of the following claims was required:

As provisionally elected by Applicant's representative, Janal Kalis, on March 12, 2001 Applicant elects to prosecute the invention of Group I, claims 1-14, 16-31 and 38 – 39 classified in class 424, subclass 443 as stated by the Examiner on page 2, second paragraph of the instant office action.

The claims of the non-elected invention, claims 32 - 39, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

#### **Claim Objections**

Claims 2 and 9 were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Both the hydrogel and the vapor emitting material are recited in claim 1. Claims 2 and 9 are hereby canceled.

#### **§112 Rejection of the Claims**

Claims 6, 14, 22 and 24 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully submits as follows:

Claim 6, as amended, dependent on amended claim 5 is in proper form and now recites: "The patch of claim 5 wherein the pad comprises a material selected from the group of materials consisting of polyolefins, acrylic adhesives and hydrogels."

Claim 14, as amended, dependent on amended claim 13 is in proper form and now recites:

“The patch of claim 13 wherein the film layer comprises a material selected from the group of materials consisting of polyolefins, polyamides, celluloses, polyethylene terephthalates, or any mixture thereof.”

Claim 22, as amended, dependent on amended claim 21 is in proper form and now recites:

“The patch of claim 21 wherein the film comprises a material selected from the group consisting of polyolefins, polyamides, celluloses, polyethylene terephthalates, or any mixture thereof.”

Original claim 24, was split into two claims, claim, 24, as amended, dependent on new claim 40 and new claim 41 dependent on amended claim 24. Amended claim 24 recites:

“The patch of claim 40 wherein the pad comprises a synthetic or natural open cell foam.”

New claim 41 recites:

“The patch of claim 24 wherein the open cell foam comprises a material selected from the group consisting of polyolefins, acrylic adhesives and hydrogels.”

Applicant respectfully submits that all of the above claims are in now patentable form under 35 USC § 112, second paragraph, and requests that the Examiner withdraw the rejections based on this section.

### **§103 Rejection of the Claims**

Claims 1, 3-8, 10-14, 16-31 and 38-39 were rejected under 35 USC § 103(a) as being unpatentable over Wick et al. (U.S. Patent No. 6,010,715) in view of Norica (U.S. Patent No. 6,033,684) and Folekemer et al. (U.S. Patent No. 3,318,769). Applicant respectfully submits that the above cited art when combined in the manner suggested by the Examiner do not achieve the structure of claim 1, which was amended to more clearly define the invention, and which now recites: “...a vapor emitting portion comprising a cellular structure attached to the base portion;

and a vapor emitting material stored within the cellular structure comprising the vapor emitting portion.” Support for this amendment is found at page 3, lines 12 – 18; page 4, lines 2 – 5 and page 6, lines 3 – 8 of the instant specification.

Applicant respectfully submits that the transdermal patch of Wick et al relies on melt blending the active agent with a permeable thermoplastic polymeric material, which is then formed into a film that acts as a carrier layer that is then formed into a laminated structure having e.g. a non-permeable backing and a pressure sensitive adhesive on the other surface of the carrier layer (see e.g. col. 2, lines 24 – 58). The Examiner concedes that Wick “...fails to teach a vapor emitting portion and a vapor emitting material.” Applicant submits that substituting the oxygen and vapor permeable outer thin film layer of Norcia for Wick’s non-permeable backing as suggested by the Examiner still produces a laminate that contains the active agent in a permeable polymer matrix and not the structure of claim 1, as amended, which relies on “...a vapor emitting portion comprising a cellular structure... and a vapor emitting material stored within the cellular structure comprising the vapor emitting portion.” Applicant further submits that substituting the resin composition of Folekemer, et al. for the carrier layer of the combined references still does not produce the patch structure of claim 1, as amended. Applicant respectfully submits that claim 1, as amended, recites novel matter and is unobvious over the cited references and is patentable under 35 USC § 103(a).

Claim 3 has been amended to make it dependent on claim 1. Claim 5, dependent on claim 1 has been amended for the sake of clarity to recite “...comprising a cellular structure...”. Claim 6 has been amended as described above under section 112 rejections. Applicant respectfully submits that claim 3, as amended, claim 4, claims 5 and 6, as amended, and claims 7 and 8 all incorporate the novel and unobvious features of claim 1 and are therefore unobvious over the cited references and are patentable under 35 USC § 103(a).

Claim 10 was amended for the sake of clarity to recite “...a foam pad comprising cells... and a vapor emitting material received by the cells of the foam pad.” Support for this amendment is found at page 4, lines 2 – 3 and page 6, lines 9 – 12. Applicant respectfully refers the Examiner to the arguments with regard to claim 1 which applicant submits apply here as

well. On this basis applicant submits that claim 10, as amended, recites novel matter and is unobvious over the cited references and is patentable under 35 USC § 103(a).

Claim 11 dependent on claim 10, was amended, to more completely claim the invention, to recite "...an open cell foam." Support for this is found at page 6, lines 9 – 12. Claim 13, dependent on claim 10 was amended for the sake of clarity with part of original claim 14 to recite "...a layer attached to the hydrogel wherein the layer attached to the hydrogel is a film, a foil or a paper." Claim 14 was amended as described above under section 112 rejections. Applicant respectfully submits that claim 11, as amended, claim 12, claims 13 and 14, as amended, all incorporate the novel and unobvious features of claim 10 and are therefore unobvious over the cited references and are patentable under 35 USC § 103(a).

Claim 16 was canceled and replaced by new claim 40 for the sake of clarity and in order to more completely claim certain aspects of the invention. New claim 40 recites "... a foam pad having portions and ...at least two vapor emitting materials separately stored in at least two separate portions of the pad." Support for this amendment can be found at page 4, lines 10 – 14 and page 6, lines 9 – 11 of the specification. Applicant respectfully refers the Examiner to the arguments with regard to claim 1 which applicant submits apply here as well. On this basis applicant submits that new claim 40 recites novel matter and is unobvious over the cited references and is patentable under 35 USC § 103(a).

Claim 17 has been amended to depend on claim 40, to correct punctuation and to more completely claim certain aspects of the invention. Claim, 17, as amended now recites "...the third layer is releasably affixed to and covers the uncovered areas of the first surface of the first layer." Support for this can be found at page 7, lines 7 – 29; page 8, lines 1 – 4 and Fig. 1 of the specification.

Claim 18 has been amended to depend on claim 40.

Claim 19 has been amended to depend on claim 40 and to more completely define the invention. Amended claim 19 recites "...the first layer comprises an adhesive from which a release layer can be released." Support is found at page 3, lines 7 – 14 of the specification.

Claim 20 dependent on claim 19 has been amended to fit the language of claim 19.

Claim 21 dependent on claim 17 has been amended for clarity by inserting elements of original claim 22.

Claim 22 has been amended as described under the section on 112 rejections.

Claim 23 has been amended to make it dependent on new claim 40 and to more completely claim the invention. Amended claim 23 recites "...the second layer comprises a removable and reattachable base substrate." Support is found at page 8, lines 3 – 4 of the specification.

Claim 24 was amended to depend on new claim 40 and as described under the section on 112 rejections.

New claim 41, inserted for clarity, dependent on claim 24, claims elements removed from original claim 24.

Applicant respectfully submits that amended claims 17 - 24 and new claim 41 all incorporate the novel and unobvious features of new claim 40 and are therefore unobvious over the cited references and are patentable under 35 USC § 103(a).

Independent claim 25 has been amended for the sake of clarity to recite: "...a vapor emitting portion comprising a cellular structure and a vapor emitting material stored within the cellular structure comprising the vapor emitting portion...". Support is the same as indicated for claim 1. Applicant respectfully refers the Examiner to the arguments with regard to claim 1 which applicant submits apply here as well. On this basis applicant submits that claim 25, as amended, recites novel matter and is unobvious over the cited references and is patentable under 35 USC § 103(a).

Applicant respectfully submits that dependent claims 26 - 28 all incorporate the novel and unobvious features of independent claim 25, as amended, and are therefore unobvious over the cited references and are patentable under 35 USC § 103(a).

Independent claim 29 has been amended for the sake of clarity to recite: "...a vapor emitting portion comprising a cellular structure and a vapor emitting material stored within the cellular structure comprising the vapor emitting portion...". Support is the same as indicated for claim 1. Applicant respectfully refers the Examiner to the arguments with regard to claim 1 which applicant submits apply here as well. On this basis applicant submits that claim 29, as

amended, recites novel matter and is unobvious over the cited references and is patentable under 35 USC § 103(a).

Applicant respectfully submits that dependent claims 30 - 31 all incorporate the novel and unobvious features of independent claim 29, as amended, and are therefore unobvious over the cited references and are patentable under 35 USC § 103(a).

Independent claim 38 has been amended for the sake of clarity to recite “a vapor emitting portion comprising a cellular structure, and a vapor emitting material stored within the cellular structure comprising the vapor emitting portion,...”. Support is the same as indicated for claim 1. Applicant respectfully refers the Examiner to the arguments with regard to claim 1 which applicant submits apply here as well. On this basis applicant submits that claim 38, as amended, recites novel matter and is unobvious over the cited references and is patentable under 35 USC § 103(a).

Applicant respectfully submits that dependent claim 39 incorporates the novel and unobvious features of independent claim 38 as amended, and is therefore unobvious over the cited references and is patentable under 35 USC § 103(a).

**References Made of Record and Not Relied On**

Applicant respectfully submits that the references made of record and not relied on, although of interest, are not as pertinent as the relied on references.

**Conclusion**

The applicant respectfully requests reconsideration of the amended, unamended and new claims now in the application and submits these claims have overcome the Examiner's rejections based on sections 112 and 103(a) and are in condition for allowance. Notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 612-373-6976 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 15 April 02

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: BOX DAC, Commissioner of Patents, Washington, D.C. 20231, on this 15th day of April, 2002.

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